

S/N 09/500,601

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sancho Enrique David

Examiner: John Winter

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Title: SYSTEM AND METHOD FOR SECURE NETWORK PURCHASING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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REMARKS

In response to the Final Office Action mailed on March 22, 2007, Applicant requests review of the rejections in the above-identified Application. Applicant respectfully traverses all rejections of the claims in the above mentioned Final Office Action. No amendments are submitted with this Request, which is being filed with a Notice of Appeal for the reasons stated below. The review is requested because it is believed that *prima facie* obviousness has not been established in the rejection of the claims for at least the reasons stated below.

§103 Rejection of the Claims

Claims 16-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Padgett et al. (U.S. 6,167,518, hereinafter “Padgett”) in view of Ross (U.S. 6,195,447), and further in view of Beetcher et al. (U.S. 5,933,497, hereinafter “Beetcher”), and further in view of Cane et al. (U.S. 5,416,840, hereinafter “Cane”).

Applicant respectfully traverses the rejection of claims 16-39 and submits that *prima facie* case of obviousness has not been established because the proposed combination of Ross, Beetcher, and Cane fails to teach or suggest each and every elements included in claims 16-39.

As shown by Applicant’s arguments presented on pages 7- 11 of Applicant’s response to the Final Office Action, claim 16 recites, “receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user, said first fingerprint file including at least one identifying characteristic of the user computer.” The Final Office Action at page 3 concedes, “Padgett et al. (‘518) does not explicitly disclose the feature of . . . receiving at least one response from the user computer, the at least one

response including a first fingerprint file and a first identification for the user.” However, the Final Office Action asserts that Ross (col. 3, lines 56-59) discloses theses claim feature. *Id*. The cited passage was analyzed in a response to a previous Non-final Office Action mailed December 17, 2004 (Applicant’s response mailed 4/13/2005, page 8). In particular, the cited passage does not mention “a first fingerprint file *and a first identification for the user*.” In contrast, Ross’s passage at col. 3 lines 56-59 states, “[a]t the local site 40, a processor 42 receives the scanned fingerprint image data from the scanner 32 across the transmission line 26 and acts to locate the real-time discrete topographic minutia points.” According to the passage, what is received is a scanned fingerprint image data and not *a first fingerprint file . . . said first fingerprint file including at least one identifying characteristic of the user computer*, as recited in claim 16. Moreover, Applicant cannot find any other passage in Ross that teaches this claimed feature. As such, Ross does not teach or suggest the limitation of *“receiving at least one response . . . one response including a first fingerprint file . . . said first fingerprint file including at least one identifying characteristic of the user computer”*, as recited in claim 16.

Claim 16 further recites:

comparing the first fingerprint file against a second fingerprint file, to verify the user computer, the second fingerprint file accessible by the verification computer, said second fingerprint file including at least one identifying characteristic of a user computer; (Emphasis added)

The Final Office Action at page 3 asserts that Ross discloses this claim feature at column 4, lines 1-7. As argued in a previous Non-final Office Action mailed December 17, 2004 (Applicant’s response mailed 4/13/2005, pages 8 and 9), the passage merely describes processing a fingerprint image to gain access to a secure area. However, the fingerprint image in Ross is not the same as the *first finger print file* and is not compared with *a second fingerprint file to verify the user computer*. Thus, the passage fails to teach *“comparing the first fingerprint file against a second fingerprint file, to verify the user computer . . . said second fingerprint file including at least one identifying characteristic of a user computer”*, as recited in claim 16.

With respect to Cane, the Final Office Action at page 2 states that Cane reference is cited as identifying the user computer. Applicant respectfully submits that the Examiner did not consider the claimed invention as a whole and only focused on the claim preamble. In

determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

In order for Cane to cure the deficiency of Padgett and Ross, it needs to be established that Cane teaches all claim features argued above with respect to the identification of user computer. Clearly, it is not sufficient for Cane to teach merely the user computer identification, it must disclose the user computer identification through the same method steps as recited in claim 16. Cane is directed to a method and system for protecting computer program distribution within a broadcast medium involving encrypting a portion of the computer program Si using an encryption scheme keyed to both an encryption key SKi and a program identifier i. (Abstract) Cane specifically discloses:

The method involves encrypting at least a portion of the computer program Si using an encryption scheme keyed to both an encryption key SKi and a program identifier i . . . Two tables are generated and stored in a memory device: a first table, including correlations between the encryption key SKi and the program identifier i; and a second table, including correlations between a password key PKj and the hardware identifier j. . . The user-transmitted program identifier i is used to access the software encryption key SKi from the first table, and the user-transmitted hardware identifier j is used to access the password key PKj from the second table. A password Pij is generated based on both the encryption key SKi and the password key PKj. The password Pij is transmitted to the user for subsequent use in decrypting the selected software program Si contained on the medium. (Col.2, lines 20-55) (Emphasis added)

In the quoted passage, the user transmits a program identifier i and a hardware identifier j. Cane then uses the identifiers i and j, respectively, to access a software encryption key and a password key stored in a first and a second tables and, based on the accessed keys, generates a password and sends the password to the user. However, the passage is silent on *a second fingerprint file including at least one identifying characteristic of a user computer*. In addition, using a hardware identifier j to access a password key from a table is not the same as *comparing the first fingerprint file against a second fingerprint file, to verify the user computer*, as required by claim 16. Thus, cane in the quoted passage does not teach “comparing the first fingerprint file against a second fingerprint file, to verify the user computer. . . said second fingerprint file including at least one identifying characteristic of a user computer,” as recited in claim 16.

Moreover, sending a password, created based on the accessed keys, to the user by Cane, is not the same as the claimed feature of *sending at least one verification response*. Because, the password sent to the user is not the same as *a verification based upon the comparing of the first fingerprint file against the second fingerprint file*, as required by claim 16. As such, Cane fails to teach or suggest the feature of "*sending at least one verification response, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user*," as recited in claim 16.

The Final Office Action at page 4 alleges that Beetcher discloses the claimed invention except for a second fingerprint file. Applicant cannot find, and the Final Office Action fails to point to any passage in Beetcher that discloses the claim features discussed above. Beetcher is directed at distributing a software without entitlement to run and separately distributing encrypted entitlement key to enable the execution of the software.

In order for the combination of Padgett, Ross, Cane, and Beetcher to teach each and every element of claim 16, Beetcher should teach what is lacking in Padgett, Ross, and Cane. However, Applicant could not find any passage in Beetcher that teaches or suggests the claim features discussed above.

Consequently, at least for the reasons set forth above, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of claim 16. As such, Applicant respectfully submits that *prima facie* case of obviousness has not been established with respect to the rejection of independent claim 16 and its dependent claims 17-33. Thus, it is requested the claim rejections under 35 U.S.C. § 103(a) be reversed.

With respect to the independent claim 34, at least for the arguments presented at pages 11- 13 of Applicant's response to the Final Office Action, which could not be repeated here because of lack of space, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of claim 34. Therefore, Applicant respectfully submits that no *prima facie* case of obviousness has been established with respect to the rejections of independent claim 34 and its dependent claims 35-39. Thus, the reversal of the claim rejections under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

In conclusion, Applicant respectfully submits that *prima facie* of obviousness has not been established in the Final Office Action for at least the reasons stated above with respect to the claims 16-39, and further that these claims are in condition for allowance. Reversal of the rejections and an indication of allowance of claims 16-39 are earnestly requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of August 2007.

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